

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: A. Maxwell Eliscu
Title: SYSTEM FOR AND METHOD
OF HANDLING REFERRALS
FROM REFERRING PARTIES
Appl. No.: 09/667,391
Filing Date: 9/20/2000
Examiner: Jennifer L. Liversedge
Art Unit: 3692
Confirmation Number: 6064

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the New **Pre-Appeal Brief Conference Pilot Program**, announced July 11, 2005, this Pre-Appeal Brief Request is being filed together with a Notice of Appeal and with the required fee.

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the reasons that follow. Claims 1-3, 5, 8-12, 14-17, 19-35, 37-52, 54, 56-64, and 66-67 are pending in this application.

Rejection under 35 U.S.C. § 112

On page 2 of the Office Action, claims 1-3, 5, 8-12, 14-17, 19-35, 37-52, 54, 56-64, and 66-67 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner states:

Newly amended language cites “providing operations which can be performed by the referral, the operations associated with managing a commercial transaction.” It is unclear how a referral provides operations. For purposes of examination, Examiner will assume operations are performed by a party or a party using a computer system. The next lines of “capturing data access information associated with what data is accessed by the referral using the provided operations” is also unclear. For purposes of examination, Examiner will interpret this to mean capturing data associated with a referral.

Applicant respectfully submits that the referral does not *provide* the operations as stated by the Examiner. According to the claim language, the referral *performs* the operations as assumed by the Examiner. Relative to the capturing element, the claim language clearly states, that the “data access information associated with what data is accessed by the referral using the provided operations” is captured. As a result, Applicant believes the claim language is clear and respectfully requests withdrawal of the rejection of claims 1-3, 5, 8-12, 14-17, 19-35, 37-52, 54, 56-64, and 66-67 under 35 U.S.C. § 112, second paragraph.

Rejection under 35 U.S.C. § 103

On page 3 of the Office Action, claims 1-3, 5, 8-12, 14-17, 19-35, 37-52, 54, 56-64, and 66-67 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2001/0049646 (Wilkinson) in view of U.S. Patent Publication No. 2001/0037265 (Kleinberg). Applicant respectfully traverses the rejection. Neither Wilkinson nor Kleinberg disclose, teach, or suggest the claimed invention as recited in claims 1-3, 5, 8-12, 14-17, 19-35, 37-52, 54, 56-64, and 66-67. Applicant also respectfully reserves the right to swear behind Wilkinson and Kleinberg as prior art references.

Claim 1 recites:

capturing data access information associated with what data is accessed by the referral using the provided operations;

forming a profile for the referral that includes the captured data access information;

Claim 56 recites:

means for capturing data access information associated with what data is accessed by the referral using the provided operations;

means for forming a profile for the referral that includes the captured data access information;

Claim 57 recites:

capture data access information associated with what data is accessed by the referral using the provided operations;

form a profile for the referral that includes the captured data access information;

On pages 3-5 of the Office Action, the Examiner states:

Wilkinson discloses a system and method comprising:

...

Providing operations which can be performed by the referral, the operations associated with managing a commercial transaction and capturing data access information associated with what data is accessed by the referral using the provided operations (pages 1-6).

Applicant notes that pages 1-6 of Wilkinson includes all but two paragraphs of the application. Applicant has carefully reviewed the entirety of Wilkinson and has failed to identify any such teaching provided by Wilkinson. Wilkinson states:

The invention may comprise a method for a service provider to facilitate one or more financial transactions between one or more suppliers of capital, one or more demanders of capital, or some combination thereof. The transaction may be between two or more suppliers, two or more demanders, or at least one demander and at least one supplier. The method comprises the steps of collecting data from a plurality of members comprising at least two suppliers, at least two demanders, or a combination thereof, and entering the data for each member into a database in association with one or more confidential codes and, optionally, an identification of an initial referring party who first referred each member to the service provider. Then, the method comprises facilitating a search of the database by or on

behalf of a searcher who is one of the members, to identify by confidential code at least one other member meeting criteria entered by the searcher. A meeting is ultimately arranged between the searcher and at least one other member identified in the search. Upon the searcher and the other member consummating a financial transaction, the service provider receives compensation from at least one of the searcher or the other member for facilitating the transaction. Optionally, the service provider shares with the initial referring party a portion of the compensation.

However, nowhere does Wilkinson disclose, teach, or suggest at least "capturing data access information associated with what data is accessed by the referral using the provided operations" as recited in claims 1, 56, and 57. Kleinberg also fails to disclose, teach, or suggest at least "capturing data access information associated with what data is accessed by the referral using the provided operations" as recited in claims 1, 56, and 57. Thus, neither Wilkinson nor Kleinberg disclose, teach, or suggest all of the elements of at least claims 1, 56, and 57. The remaining claims depend from claim 1. Therefore, Applicant respectfully requests withdrawal of the rejection of claims 1-3, 5, 8-12, 14-17, 19-35, 37-52, 54, 56-64, and 66-67.

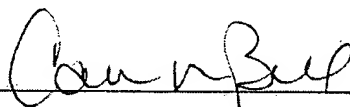
In view of the foregoing, it is respectfully submitted that the application is in condition for allowance.

Respectfully submitted,

Date March 6, 2008

FOLEY & LARDNER LLP
Customer Number: 23524
Telephone: (608) 258-4263
Facsimile: (608) 258-4258

By



Callie M. Bell
Attorney for Applicant
Registration No. 54,989